

REMARKS

- Claims 1 – 64, and 66 are currently pending in the present application.
- Of the pending claims, only claims 1, 55, 58 – 60, and 66 are independent.
- All claims stand rejected under 35 U.S.C. §103(a), albeit over different combinations of patents.

Initially, Applicants would like to thank the Examiner for granting an interview November 5, 2004 to discuss the pending claims in light of the Examiner's rejections in the Final Office Action, mailed April 13, 2004. As discussed below, Applicants have amended the claims in accordance with agreement reached with the Examiner during the interview.

I. RCE

This Amendment and Response is being filed in response to a Final Office Action. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of this Amendment and Response.

II. Claims 1 – 11, 13, 16 – 33, 49 – 52, 54 – 58 and 66

Claims 1 – 11, 13, 16 – 33, 49 – 52, 54 – 58 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,285,986 to Andrews et al. ("Andrews" herein) in view of U.S. Patent No. 5,970,469 to Scroggie et al. ("Scroggie" herein). Applicants respectfully traverse this rejection for the reasons set forth below.

II.(a). Claims 1 and 58

None of the prior art, alone or in combination, teaches or suggests the following feature that is recited in each of claims **1 and 58**:

- *selecting, via a controller, a subset of the plurality of products for each of the product categories associated with the offer amount*

The above emphasized feature was already inherent in the claimed embodiments and Applicants have amended the claim to expressly clarify the order of the method steps.

Applicants and the Examiner agreed during the Interview conducted November 5, 2004 that neither Andrews nor Scroggie teach or suggest the above limitation. Specifically, neither Andrews nor Scroggie teach or suggest *selecting a subset of the plurality of products for each of the product categories via a controller after receiving buyer offer information*. For at least this reason, Applicants respectfully request reconsideration and withdrawal of the rejection against independent claims **1 and 58**.

II.(b). No Motivation To Combine Provided

In addition to traversing the rejection of claims **1 and 58** on the grounds that the prior art does not teach or suggest all claim features, Applicants additionally traverse this rejection on the grounds that no motivation to combine the prior art in the manner suggested has been provided.

It is the burden of the Examiner to make particular findings in the record as to why one of ordinary skill in the art, without having the benefit of first having read Applicants' disclosure, would have made the combination of references proposed.

No such findings have been provided for the rejection. Instead, the Examiner has merely asserted that each of the claim features is taught by one of the respective references, "[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and apparatus of Andrews, to include the selecting a subset and providing an indication of the selected products and the receiving of the indication from the buyer, as taught by Scroggie, in order to automatically sell and promote groups of products and services (Andrews col. 1, lines 28 – 29)." Current Office Action, page 12.

“Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure.” Cardiac Pacemakers v. St. Jude Medical, 381 F.3d 1371, 1377 (Fed. Cir. 2004).

The above statement by the Examiner merely states that one of ordinary skill in the art would have been motivated to make the proposed combination because the combination would allegedly have resulted in the claimed combination and a desirable result would have been produced.

The statement of motivation to combine provided by the Examiner is insufficient to meet the Examiner’s burden of establishing why one of ordinary skill in the art would have made the proposed combination because the statement is a quote directly from Andrews of a result that Andrews itself states that it accomplishes. Since, upon reading Andrews, one of ordinary skill in the art would be taught that the Andrews system satisfies the purpose provided by the Examiner as the motivation to combine. In other words, one of ordinary skill in the art would not be motivated to modify the Andrews system in any manner to accomplish the purpose provided by the Examiner.

For convenience, Applicants made a more detailed argument with respect to the Examiner’s failure to provide a sufficient motivation to combine in Applicants’ prior response.

II.(c). Claims 2 – 11, 13, 16 – 33, 49 – 52, 54, 56 and 57 (each dependent from either claim 1 or claim 55)

Claims **2 – 11, 13, 16 – 33, 49 – 52, 54, 56 and 57** each include the claim features discussed in Section I.(a). and are thus patentable at least for the same reasons as claims **1 and 55** (also discussed in Section II.(a)).

Additionally, Applicants respectfully disagree with the Examiner’s statement regarding claim **13**, that Andrews discloses “receiving the buyer offer information from a buyer”. First, the Examiner is misstating the actual claim limitation. The claim limitation of claim **13**, when read in the full context of the claim, is that “the indication of an offer amount comprises a buyer-defined offer amount” and that the offer amount is

“associated with a plurality of product categories” and is included in “buyer offer information.” Andrews does not teach or suggest receiving buyer offer information that includes a buyer-defined offer amount that is associated with a plurality of product categories (as Applicants argued in the Response to the Previous Office Action).

Andrews does teach receiving a bid from a buyer for a bundle of products. However, a bundle of products is a single product category under the Examiner’s interpretation.

Andrews does not teach or suggest receiving a bid that is associated with a plurality of bundles or product categories.

Applicants have made this argument in Applicants response to the Office Action dated September 16, 2003.

Applicants went on to argues however, that Andrews does not teach receiving buyer offer information that includes an offer amount, where the offer amount is associated with a plurality of product categories.

Regarding claim 13 (as well as claims 1, 55, 58 and 60), Applicants maintain that Andrews does not teach or suggest the claim feature of receiving buyer offer information, including an offer amount *that is associated with a plurality of product categories*.

II.(d). Claim 66 (independent)

None of the prior art, alone or in combination, teaches or suggests the following claim feature, which is recited in claim 66 as amended:

- *receiving, via a controller, an indication of selected products associated with the offer amount, the selected products comprising at least one product from each of the plurality of product categories and the selected products having been selected by an entity other than the buyer.*

As discussed in Section II.(a)., neither Andrews or Scroggie teaches or suggests selecting, via a controller, a product or subset of products for each of a plurality of product categories after providing buyer offer information. Accordingly, claim 66 is allowable over the prior art for the same reasons as claims 1, 55 and 58.

III. Claims 12, 14 – 15, 34 – 39, 42 – 48, 60 and 63 – 64

Claims 12, 14 – 15, 34 – 39, 42 – 48, 60, and 63 – 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews in view of Scroggie and further in view of U.S. Patent No. 6,401,080 to Bigus et al. (“Bigus” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

III.(a). Claims 12, 14 – 15, 34 – 39 and 42 – 48

Each of claims 12, 14 – 15, 34 – 39 and 42 – 48 is dependent from claim 1. Accordingly, each of claims 12, 14 – 15, 34 – 39 and 42 – 48 includes the claim feature of “selecting, by an entity other than a buyer, a subset of the plurality of products for each of the product categories and is thus patentable at least for the same reasons as claim 1 (discussed above in Section II.(a)).

III.(b). Claim 60 (Independent)

None of the prior art, alone or in combination, teaches or suggests the following claim feature that is recited in claim 60 as amended:

- *selecting, via a controller, a subset of the plurality of products for each of the product categories associated with the offer amount*

As discussed in Section II.(a)., neither Andrews or Scroggie teaches or suggests selecting, via a controller, a product or subset of products for each of a plurality of product categories after receiving buyer offer information. Bigus also does not teach or suggest such a feature. Accordingly, claim 60 is allowable over the prior art for the same reasons as claims 1 and 58.

III.(c). Claims 63 – 64 (each dependent from claim 60)

Claims 63 and 64 are each dependent from claim 60. Accordingly, claims 63 and 64 include the feature of “selecting, by an entity other than a buyer, a subset of the

plurality of products for each of the product categories” and are patentable at least for the same reasons as claim 60.

III.(d). No Motivation to Combine Has Been Provided

In support of the combination of Scroggie, Andrews and Bigus, the Examiner has merely stated that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made [sic] to modify the combination of Andrews and Scroggie to include the offers, as taught by Bigus, in order to provide a productive, adaptive, secure and efficient negotiations skills [sic] for conducting commercial transactions (Bigus col. 3, lines 42 – 45).” Current Office Action, bottom of page 16.

This statement is insufficient to meet the Examiner’s burden of establishing a prima facie case of obviousness, for the same reasons discussed in Section II.(b).

Further, the statement of motivation to combine provided by the Examiner is insufficient to meet the Examiner’s burden of establishing why one of ordinary skill in the art would have made the proposed combination because the statement is a quote directly from Bigus of a result that Bigus itself states that it accomplishes. Since, upon reading Bigus, one of ordinary skill in the art would be taught that the Bigus system satisfies the purpose provided by the Examiner as the motivation to combine. In other words, one of ordinary skill in the art would not be motivated to modify the Bigus system in any manner to accomplish the purpose provided by the Examiner.

IV. Claims 40 – 41 and 61 – 62

Claims 40 – 41 and 61 – 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews, Scroggie, and Bigus in further view of U.S. Patent No. 5,905,975 to Ausubel (“Ausubel” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Claims 40 – 41 are each dependent from claim 1. Claims 61 – 62 are each dependent from claim 60. Accordingly, claims 40 – 41 include all of the limitations of claim 1 and are patentable at least for the same reasons as discussed with respect to claim 1 and claims 60 – 61 include all of the limitations of claim 60 and are patentable at least for the same reasons as discussed with respect to claim 60. Further, Ausubel, like

Andrews and Scroggie, does not teach or suggest “after said receiving buyer offer information, selecting, by an entity other than a buyer, a subset of the plurality of products for each of the product categories.”

Applicants also traverse the rejection of claims **40 – 41 and 61 – 62** on the grounds that no proper motivation to combine the references has been provided. The statement provided by the Examiner on page 10 of the Current Office Action, that “[i]t would have been obvious...to modify the combination, to include the penalty, as taught by Ausubel, in order to avoid withdrawing of bids (Ausubel col. 30 lines 16 – 18)” is insufficient to meet the Examiner’s burden of establishing a prima facie case of obviousness for the reasons discussed above with respect to the other statements of motivations to combine provided by the Examiner.

The statement is also insufficient to establish a motivation to combine because, again, it is a direct quote from one of the references (Ausubel) of a purpose accomplished by that reference. Accordingly, one of ordinary skill in the art would not have been motivated to attempt to modify the reference in order to accomplish the purpose since the reference itself already states that it accomplishes the purpose.

V. Claim 53

Claim **53** stands rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews and Scroggie in further view of U.S. Patent No. 5,890,136 to Kipp (“Kipp” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Claim **53** is dependent from claim **1**. Accordingly, claim **53** includes the limitation of “*selecting, via a controller, a subset of the plurality of products for each of the product categories associated with the offer amount*” and is patentable at least for the same reasons as claim **1**. Kipp, like Andrews and Scroggie, does not teach or suggest the quoted claim feature.

Applicants also traverse the rejection of claim **53** on the grounds that no proper motivation to combine the references has been provided. The statement provided by the Examiner on page 10 of the Current Office Action, that “[i]t would have been obvious...to modify the combination, to include the taking possession of the selected products at a merchant, in order to pickup the article (Kipp col. 2, lines 24 – 25)” is

insufficient to meet the Examiner's burden of establishing a prima facie case of obviousness for the reasons discussed above with respect to the other statements of motivations to combine provided by the Examiner.

The statement is also insufficient to establish a motivation to combine because, again, it is a direct quote from one of the references (Kipp) of a purpose accomplished by that reference. Accordingly, one of ordinary skill in the art would not have been motivated to attempt to modify the reference in order to accomplish the purpose since the reference itself already states that it accomplishes the purpose.

VI. Claim 59

Claim 59 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews in view of Scroggie in further view of Bigus and in further view of Kipp. Applicants respectfully traverse this rejection for the reasons set forth below.

None of the prior art references, alone or in combination, teach or suggest the following claim features, which are recited in claim 59:

- *receiving from the buyer an indication of a first product category associated with a first set of products and a second product category associated with a second set of products; and*
- *selecting a first product from the first set of products associated with the offer amount*

In other words, as in the other independent claims discussed above, the selection of products from a product category is performed by an entity other than a buyer after receiving the buyer offer. As discussed above, none of Scroggie, Andrews, Bigus or Kipp teach or suggest this feature.

Applicants also traverse the rejection of claim 59 on the grounds that no proper motivation to combine the references has been provided. The statements provided by the Examiner on page 20 of the Current Office Action are insufficient to meet the Examiner's burden of establishing a prima facie case of obviousness for the reasons discussed above with respect to the other statements of motivations to combine provided by the Examiner.

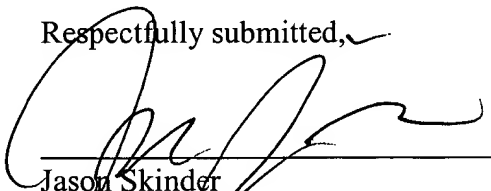
VII. Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at jskinder@walkerdigital.com.

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Respectfully submitted, ✓



Jason Skinder
Attorney for Applicants
Registration No. 47,094
Walker Digital, LLC
jskinder@WalkerDigital.com
203-461-7017 / voice
203-461-7300 / fax